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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 08/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/621,223

Applicant(s)

AYOUB, ABBY

Examiner

Jordan M. Schwartz

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2873

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities: "at lest" should be corrected to "at least" to correct a typographical error. Appropriate correction is required.

Examiner's Comment

For applicant's information, claim 13 is now directed to removing excess coating from the face of the lens but the changes in the marked up version (underlined version) of amended claim 13 are inconsistent with original claim 13, which was directed to the heat source being ultraviolet light. The amended claim 13 (now dependent from claim 12) directed to the "removing excess coating" has been entered but it is not clear if it was applicant's intention to change claim 13 in this manner since the underlined changes are inconsistent with the original claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-5, 7-10, 12-13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al.

Brown et al reads on these claims by disclosing the limitations therein including the following: an apparatus (abstract re eyeglasses); comprising a lens (abstract); a

Art Unit: 2873

coating affixed to at least a portion of only the edge of the lens (abstract, column 5, lines 52-62); the coating as colored (column 5, line 51 re "slightly colored materials"). Brown et al further discloses the coloring as translucent (column 5, line 52); and the lens affixed to an eyeglass frame (abstract). Eyeglass frames inherently have some color, this being reasonably based upon the well known use of colored eyeglass frames. The "slightly colored materials" for the edge coating will inherently not match the eyeglass frame color, this being reasonably based upon the coatings as "slightly colored" while eyeglass lens frames are generally more than slightly colored. Brown et al further discloses that the coating is not affixed to the face of the lens (column 5, lines 56-62); a method of applying the coating to at least a portion of the edge of the lens (column 5, line 56); placing the lens under a heat source (column 4, lines 25-46, column 5, lines 40-63); and allowing the coating to dry before placing the lens under the heat source (column 5, line 61). The method of Brown et al would inherently remove any excess coating from the face of the lens, this being reasonably based upon Brown et al disclosing the coating being applied to the edge of the lens through a paint brush and not to the face of the lens (column 5, line 56), similar to that of the claimed invention.

Claims 1, 3, 8-10, 12-14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Grendahl.

Grendahl reads on these claims by disclosing the limitations therein including the following: an apparatus (abstract re implantable lens); comprising a lens (Figures 1 and 7, column 5, line 67 re lens element "32"); a coating affixed to at least a portion of only the edge of the lens (column 6, line 3). The coating will inherently be colored, this being

Art Unit: 2873

reasonably based upon Grendahl disclosing the coating as "highly pigmented" and "opaque" (column 6, line 3). The application of the coating will inherently include a method of applying the colored coating. Grendahl further discloses the coating as opaque (column 6, line 5). The coating of Grendahl would inherently not be affixed to the face of lens element "32" this being reasonably based upon Grendahl specifically disclosing the coating affixed to the edge of the lens (column 6, line 3). Grendahl further discloses placing the lens under a heat source (column 4, line 18); and allowing the coating to dry before placing the lens under the heat source (column 4, line 18 in that the lamination of the two lenses (during which heat is applied) would inherently take place after the formation and coating of the lens elements). The method of Grendahl would inherently remove any excess coating from the face of the lens, this being reasonably based upon Grendahl disclosing that the coating would be applied to only the edge of the lens and not the optical portion to apply anti-reflective properties (column 6, line 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al in view of Burzynski.

Art Unit: 2873

Brown et al discloses as is set forth above but does not specifically disclose the lens further comprising a scratch-resistant coating. However, the examiner takes Judicial Notice of the fact that it is well known in the art of ophthalmic lenses to impart ophthalmic lenses with scratch-resistant coatings. Regardless, Brown et al discloses that the lenses can be formed of polycarbonate materials (column 7, line 12). Burzynski teaches that polycarbonate ophthalmic lenses can be imparted with a scratch-resistant coating in order to impart scratch-resistant properties to the lens (column 1, line 15-35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lenses of Brown et al imparted with a scratch-resistant coating since it is well known in the art of ophthalmic lenses to impart ophthalmic lenses with scratch-resistant coatings and since Burzynski teaches that polycarbonate ophthalmic lenses can be imparted with a scratch-resistant coating in order to impart scratch-resistant properties to the lens.

Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al.

Brown et al discloses as is set forth above but does not disclose the coating matching the color of the frame. However, Brown et al teaches that the colored edge should not be distracting to the wearer and should take into account cosmetic appeal (column 5, line 48). Having a coating matching the lens would decrease distraction to the wearer and would be an obvious matter of design choice to impart cosmetic appeal to the lens. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the coating of Brown et al matching the

Art Unit: 2873

color of the frame since Brown et al teaches that the colored edge should not be distracting to the wearer and should take into account cosmetic appeal and having a coating matching the lens would decrease distraction to the wearer and would be an obvious matter of design choice to impart cosmetic appeal to the lens.

Prior Art Citations

Ripley was cited in the last office action and would still read on or make obvious a number of the above rejected claims (see for example column 2, line 46 and claim 2) however, such a rejection would have been repetitive.

Response to Arguments

Applicant's arguments filed May 31, 2002 have been fully considered but, with respect to the Brown rejection (and Brown in view of Burzynski), they are not persuasive.

Applicant argues that Brown teaches that a transparent to highly translucent and colorless material was preferred. However, independent claims 1 and 9 are very broad claims requiring a colored coating affixed to at least a portion of only the edge of the lens. Brown specifically discloses that the coating can be "slightly colored" (column 5, line 52). A slightly colored material as a coating is a "colored coating". Furthermore, this coating is being applied to only the edge of the lens (column 5, line 56 i.e. "applied to the edge of the lens with a paint brush or a syringe"). Therefore, Brown reads on these claims as set forth in the rejection above. Applicant further argues that a hue is being added to the lens by immersing the lens in a bath dye, however, applicant is not claiming that the face of the lens is clear. Applicant is merely claiming that a colored

Art Unit: 2873

coating is affixed to a least a portion of only the edge of the lens. Therefore, the colored coating to the edge can be in addition to a lens dye. Brown discloses that in addition to this bath dye, a coating is being affixed to only the edge of the lens and the coating is colored as stated above. Therefore Brown discloses, "a colored coating affixed to a least a portion of only the edge of the lens" and the method of applying the colored coating.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703)

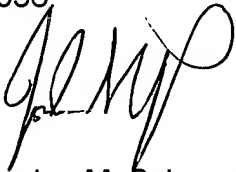
Art Unit: 2873

308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

0956

A handwritten signature in black ink, appearing to read 'J. Schwartz', written over a horizontal line.

Jordan M. Schwartz
Primary Examiner
Art Unit 2873
July 10, 2002